

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)	
)	Group Art Unit: 3739
Huy D. Phan, et al)	
)	Confirmation No. : 7044
Serial No.: 10/660,820)	
)	Examiner: Vrettakos, Peter J.
Filed: September 12, 2003)	
)	
For: ABLATION CATHETER WITH)	
TISSUE PROTECTING ASSEMBLY)	

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This letter is in response to the Office Action, dated June 8, 2007. Based on the following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Rejections-35 U.S.C. §103

Claims 1-11, 13, 14, and 18 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,529,775 ("Whitebrook"). Applicant respectfully traverses this rejection, since Whitebrook does not disclose, teach, or suggest the combination of elements required by these claims.

CERTIFICATE OF TRANSMISSION

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being transmitted to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below via the USPTO EFS-Web filing system.

9/10/07
Date of Deposit


Jocelyn L. Lee

Notably, to make out a prima facie case of obviousness, the Examiner must set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
 - (B) the difference or differences in the claim over the applied reference(s),
 - (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
 - (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.
- (See MPEP §706.02(j))

Applicant submits that the Examiner has failed to set forth at least prongs (C) and (D) of this requirement, and thus, has not made out a prima facie case that claims 1-11, 13, 14, and 18 are obvious over Whitebrook.

With respect to prong (C), the Examiner simply has not shown in what manner a single embodiment disclosed in Whitebrook is to be modified to arrive at the claim 1 invention. In particular, the Examiner refers to various embodiments disclosed in Whitebrook to support the conclusion that Whitebrook discloses every element required by claim 1, and then states that the embodiments can somehow be modified to come up with the claimed invention. However, not only does the Examiner fail to specifically set forth what modifications are to be made, the Examiner has failed to set forth what embodiment disclosed in Whitebrook is to be modified.

To the extent that the Examiner relies on the hypothetical combination made in the advisory action, dated May 22, 2007, such hypothetical combination would still not satisfy prong (C). In particular, the Examiner stated that elements 402, 404, and 406 of Fig. 4a can be substituted into structure 440 in Fig. 4i. However, it is not known what elements in Fig. 4i are to be substituted with the elements 402, 404, and 406 of Fig. 4a, or how the

spacers 444 (as the cage assembly) are to be arranged with the ground electrode 402, emitter 404, and blood 406. Notably, blood 406 is intended to flow between the ground electrode 402 and emitter 404 of the Fig. 4a embodiment, and blood 406 is intended to flow through the spacers 444 in the Fig. 4i embodiment. Thus, combining these embodiments does not make sense. For example, how is the blood 406 to flow in this so-called hypothetical embodiment—between the ground electrode 402 and the emitter 404 or between the emitter 404 and the spacers 444. If the former, why would you need the spacers 444 outside of the ground electrode 402 in this hypothetical embodiment if the blood flows between the ground electrode 402 and the emitter 404? If the latter, there would be no blood to heat between the emitter 404 and ground electrode 402, so why would you need the ground electrode 402?

With respect to prong (D), the Examiner simply has not explained why one of ordinary skill in the art would be motivated to make whatever modification the Examiner believes should be made to the embodiments disclosed in Whitebrook. Significantly:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (See MPEP §706.02(j)) (emphasis added).

Instead of pointing to anywhere in Whitebrook that suggests the claim 1 invention, the Examiner has merely cited boilerplate language in Whitebrook that modifications can be made to the embodiments. However, the fact that a patent, as with almost all patents, sets forth a statement that modifications can be made to the disclosed embodiments does not give the Examiner license to modify the disclosed embodiments in any manner of his

choosing. Clearly, to make out a prima facie case of obviousness, the Examiner must show more than the fact that an embodiment can be modified, since any embodiment in whatever context can always be modified.

In sum, the Examiner has not shown what embodiment in Whitebrook is to be modified, what modifications are to be made to the Whitebrook embodiment, and any suggestion in Whitebrook or any other prior art references to make whatever modifications to whatever embodiment the Examiner believes would result in the claimed invention.

As such, Applicant submits that independent claim 1, as well as the claims depending therefrom (claims 2-11, 13, 14, and 18), are not obvious over Whitebrook, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are allowable, and thus, a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: September 10, 2007

By:


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